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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,927	12/21/2000	Dave Snowdon	D/99630	2867
7590	05/09/2005		EXAMINER	
John E. Beck Xerox Corporation Xerox Square 20A Rochester, NY 14644			MILIA, MARK R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,927

Applicant(s)

SNOWDON ET AL.

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 11/1/04, and has been entered and made of record. Currently, claims 1-21 are pending.

Drawings

2. Applicant's amendments to the drawings were received on 11/1/04. These drawings are acceptable and overcome the objections as cited in the previous Office Action. Therefore the objections are withdrawn.

Specification

3. Applicant's amendments to the specification received on 11/1/04 have overcome the objections as cited in the previous Office Action. Therefore the objections have been withdrawn.

Response to Arguments

4. Applicant's arguments filed 11/1/04 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the rejection of claims 1-3, 7, 9, 10-13, and 15-17, wherein on pages 9-10, the applicant explains how the current invention differs from the teachings of Ostrover. Particularly, the applicant states that the current invention has a computer attached to a physical document that includes a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document. Examiner agrees that Ostrover does not disclose a processor that updates and modifies the recorded information in digital form and the metadata pertaining to the physical document, however the applicant's invention does not disclose a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document. In the applicant's disclosure it is stated that the digital information pertaining to the physical document is updated, modified, and recorded onto the computer through a modified image forming device (see page 3 line 18-page 4 line 4, page 4 lines 13-21, and page 8 lines 3-11). The amended claim element has no support in the specification for a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document. Further, Ostrover discloses an analogous system to that of the applicant's invention, one that utilizes a modified image forming device that updates, modifies, and records digital data pertaining to a physical

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document onto a microchip capable of storing electronic data, the microchip comprising an input/output, a memory, and a processor (see column 5 lines 15-20, column 5 line 66-column 6 line 5, and column 6 lines 16-60).

Therefore, the rejection of claims 1-20, as cited in the Office Action dated 7/28/04, is maintained and repeated in this Office Action. Newly added claim 21 will be addressed in the following claim rejections.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 7, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The above claims have been amended to include claim limitation wherein a computer attached to the physical document includes a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document. This limitation has no support in the disclosure and is considered new matter.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This claim has no support in the disclosure and is considered new matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 9, 10-13, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6585154 to Ostrover et al. Ostrover clearly teaches a programmable physical document including all the limitations recited in claims 1-3, 7, 9, 10-13, and 15-17.

Regarding claim 1, Ostrover teaches a programmable document comprising a physical document including at least one sheet of material and information recorded

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thereon (see column 4 lines 27-29 and 43-45), and a computer attached to the physical document, wherein the computer includes an input/output device, a memory storing the recorded information in digital form and metadata pertaining to the physical document, and a processor for updating and modifying the recorded information in digital form and the metadata pertaining to the physical document (see column 3 lines 38-42 and 63-67, column 4 lines 1-13 and 46-67, and column 5 lines 1 and 15-20, reference states that the data may be in a standard file format in which the examples listed inherently have metadata).

Regarding claim 2, Ostrover teaches wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information (see column 4 lines 43-64, reference states that the data may be in a standard file format in which the examples listed inherently have metadata).

Regarding claim 3, Ostrover teaches wherein the computer is attached to the physical document by at least one of an adhesive, a removable adhesive, a magnetic material (see column 5 lines 2-9).

Regarding claim 7, Ostrover teaches a programmable document comprising a physical document including at least one sheet of material for receiving information recorded thereon (see column 4 lines 27-29 and 43-45), and a computer attached to the physical document, wherein the computer includes an input/output device, a processor for updating and modifying information pertaining to the physical document and a memory for storing information pertaining to the physical document (see column 3 lines

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38-42 and 63-67, column 4 lines 1-13 and 46-67, and column 5 lines 1 and 15-20), a recording device for recording information on a sheet of material (see column 5 lines 16-22 and 66-67 and column 6 lines 1-3), a device for attaching a computer to a physical document (see column 6 lines 16-22), and a reader for reading information from and writing information to the programmable document computer (see column 6 lines 46-60).

Regarding claim 9, Ostrover teaches wherein the recording device is selected from the group consisting of printer, copier, scanner and multi-function device (see column 6 lines 53-60).

Regarding claim 10, Ostrover teaches recording information on at least one sheet of material to generate a physical document (see column 5 lines 16-22 and 66-67 and column 6 lines 1-3), storing a digital copy of the recorded information and metadata pertaining to the physical document in a computer, wherein the computer includes an input/output device, a processor for updating and modifying information pertaining to the physical document and a memory (see column 3 lines 63-67, column 4 lines 1-10, and column 6 lines 53-60), associating the stored information with the physical document (see column 6 lines 16-22), and attaching the computer to the physical document (see column 5 lines 1-9).

Regarding claim 11, Ostrover teaches performing an activity pertaining to the physical document and storing a digital record of the performed activity in the computer (see columns 4-6, reference teaches that information is recorded on a physical

document, i.e. paper, and digital data is stored on a microchip that is an electronic copy of the information recorded on the physical document).

Regarding claim 12, Ostrover teaches wherein the metadata comprises processing information, version information, user comments, copy information, transformation information, distribution information or index information (see column 4 lines 43-64, reference states that the data may be in a standard file format in which the examples listed inherently have metadata).

Regarding claim 13, Ostrover teaches wherein the computer is attached to the physical document by an adhesive (see column 5 lines 2-9).

Regarding claim 15, Ostrover teaches wherein the activity is selected from the group consisting of copying, providing comments, scanning, referencing an earlier version of the information (see columns 5 and 6, reference teaches a device which reads/writes to the microchip can be one of a printer, photocopy machine or a scanner, a photocopy or printer can be used to record information on the physical document and the digital representation of which is stored in the microchip).

Regarding claim 16, Ostrover teaches wherein the metadata comprises at least one of an electronic copy of the information recorded on the physical document, comments by readers of the document, state changes and edits made since the document was printed, processing information, version information, copy information, transformation information, distribution information, index information, and other miscellaneous information (see column 3 lines 60-67 and column 4 lines 1-10 and 43-64).

Regarding claim 17, Ostrover teaches wherein the miscellaneous information comprises at least one of a document summary and key words (see column 6 lines 16-19, reference shows at least a portion of the content of the electronic copy of the physical document is stored in the memory device of the microchip which is equivalent to a document summary).

Regarding claim 21, Ostrover teaches a computer program, stored in the memory, for implementing defined actions, operable by the processor (see column 4 lines 1-23, column 5 lines 9-45, and column 6 lines 1-60).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover as applied to claims 1 and 7 above, and further in view of U.S. Patent No. 6533171 to Porter.

Ostrover does not disclose expressly wherein the computer comprises an iButton.

Porter discloses a similar system that makes use of an iButton (see column 2 lines 21-25, column 4 lines 35-48, and column 5 lines 1-7).

Ostrover & Porter are combinable because they are from the same field of endeavor, electronic data copies of physically printed documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the microchip of Ostrover with the iButton of Porter.

The suggestion/motivation for doing so would have been to provide a more efficient way to store electronic data corresponding to a copy of a physical document. Porter teaches a system in which an iButton or smart card is used to store information that would normally appear on a business card (which is analogous to the computer in the claimed invention). The iButton or smart card can then be used in conjunction with a reader to send the stored information via e-mail to another participant. With Porter's system an individual no longer is required to carry a sufficient number of business cards or have to worry about how to carry and store them on his person. Also, more information can be stored in the iButton or smart card than on a traditional business card and the iButton or smart card can change and edit information that would normally force the individual to waste and/or reprint traditional business cards (see column 1).

Therefore, it would have been obvious to combine Porter with Ostrover to obtain the invention as specified in claims 5, 8, and 19.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover as applied to claim 1 above, and further in view of U.S. Patent No. 5459307 to Klotz, Jr.

Ostrover does not disclose expressly wherein the computer has a machine-readable label.

Klotz discloses a machine-readable label (see column 3 lines 54-66 and column 5 lines 1-7 and 20-33, reference teaches a machine readable file storage sheet flag which informs the system that a machine readable sheet containing digitally encoded files is going to be read).

Ostrover & Klotz are combinable because they are from a similar problem solving area, notifying system about current document by way of a machine-readable label.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the machine-readable label of Klotz with the microchip of Ostrover.

The suggestion/motivation for doing so would have been the ability to notify the system about the current document that is about to be read. Klotz teaches the significance of the label is to inform the system that a file storage sheet follows and in turn the system knows where to scan the page for file attribute information. By implementing this advantage into the current invention allows a "modified" (as stated by applicants) printer, photocopier, or fax machine to know when the system is going to process a document that has an attached computer and enable read/write capabilities.

Therefore, it would have been obvious to combine Klotz with Ostrover to obtain the invention as specified in claim 6.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover as applied to claim 1 above, and further in view of U.S. Patent No. 6477243 to Choksi et al.

Ostrover does not disclose expressly storing a URL for a digital version of the information recorded on the physical document.

Choksi discloses storing a URL for a digital version of the information recorded on the physical document (see column 3 lines 55-64, column 8 lines 49-67, and Fig. 5, reference teaches a system in which upon receiving a facsimile message a confirmation message is sent to the user notifying the user of the facsimile message and the URL where the message is located).

Ostrover & Choksi are combinable because they are from the same field of endeavor, electronic storage of a physical document.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the larger storage space provided by a URL of Choksi with the idea of storing an electronic copy of a physical document of Ostrover.

The suggestion/motivation for doing so would have been storing electronic data corresponding to a physical document by using a URL because of the larger amount of storage space available on a network environment. Choksi points out the benefits of being able to transmit larger files by way of a message containing a URL which points to the location of a document rather than sending the file as an attachment in a e-mail message and risking the file exceeding a certain size limit and thus being stripped off the e-mail or being unable to send the attachment (see column 1).

Therefore, it would have been obvious to combine Choksi with Ostrover to obtain the invention as specified in claim 18.

Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover as applied to claims 1 and 10 above, and further in view of U.S. Patent No. 5417508 to Friedman.

Ostrover does not disclose expressly wherein the computer is attached to the physical document by a spiral binding.

Friedman discloses attaching physical documents with a spiral binding (see Figs. 1-5, column 2 lines 58-67, and column 3 lines 1-45).

Ostrover & Friedman are combinable because they are from a similar problem solving area, attachment of multiple documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the attachment of documents using a spiral binding of Friedman with the attachment of documents and microchips of Ostrover.

The suggestion/motivation for doing so would have been to physically attach the microchip to the physical document.

Therefore, it would have been obvious to combine Friedman with Ostrover to obtain the invention as specified in claims 4 and 14.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ostrover. Ostrover fails to explicitly disclose wherein the metadata comprises text, or

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portions thereof, of the information recorded on the document which has been translated into another language. However, Ostrover does state that the digital data can be in a number of different formats or languages and it is known in the art that metadata is data about data and refers to things such as origin, size, and formatting, and it is also known in the art that files or documents are changed to different formats on a regular basis for a multitude of reasons. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention that metadata stores text, or a portion thereof, of the information recorded on the document which has been translated into another language.

Conclusion

2. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
Examiner
Art Unit 2622

MRM

JOSEPH R. POKRZYWA
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